

Remarks

Claims 1-36 are pending in this patent application. By this amendment, claims 32-36 are added and claims 1, 2 and 31 are amended for, among other things, clarity and readability. Support for the amendment to claims 1 and 31 and for new claims 32-36 can be found in the originally filed claims and in instant specification at the first full paragraph of page 5. No new matter has been added. Reconsideration of the rejected claims in view of the above amendments and the following remarks is respectfully requested.

Interview of April 22, 2005

Applicant appreciates the courtesy extended by Examiner Safavi in the Interview of April 22, 2005. In that interview, Applicant's representative discussed, among other things, that none of the applied documents discloses or suggests pre-applying at an off-site location the recited adhesive or substance and thereafter connecting the components. The Examiner agreed that the applied documents do not teach pre-applying the adhesive or the substance in, e.g., a factory setting, but disagreed with Applicant's representative's conclusion noting that because such a feature cannot be given patentable weight in an apparatus claim, the references render the claims unpatentable.

Applicant's representative specifically argued that such a recitation is a structural feature because it forms a tangible part of the claimed invention. Applicant's representative explained that a device which contains a pre-applied adhesive is structurally distinguishable from a device which does not contain a pre-applied

adhesive and requires one to later apply a coating. Thus, a label having an adhesive backing is structurally distinguishable from a label which does not and requires a user to apply an adhesive in order to attach it to a surface. In response to these arguments, the Examiner insisted that such features relate to process limitations and will be completely disregarded in apparatus claims.

35 U.S.C. 103 Rejections:

Claims 1-3, 21-25 and 31 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Austrian reference 405,560 ("AT '560") in view of German reference 297 03 962 ("DE '962") and in further in view of any one of U.S. Patent No. 5,323,584 to SCARLETT, U.S. Patent No. 4,195,462 to KELLER et al., or U.S. Patent No. 5,899,251 to TURNER. Applicant respectfully traverses this rejection.

In order for a prior art reference or combination of references to render a claim obvious, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the reference or references, when combined, must disclose or suggest all of the claim limitations. The motivation to modify the prior art and the reasonable expectation of success must both be found in the prior art and not based upon a patent applicant's disclosure. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claim 1 recites "a configuration for combining flat structural components" in which "a pre-applied adhesive layer, or a pre-applied layer of a substance which activates adhesive, is applied off-site and is present on the groove at least in the area of

its divergent sides or on the tongue at least in the area of its divergent wedge-shaped area, or on both areas.” Claim 31 recites “a pre-applied adhesive layer or pre-applied substance which activates adhesive applied off-site and being present on the groove at least in the area of the divergent sides or on the tongue at least in the area of the divergent wedge-shaped area, or on both areas.”

The Examiner’s position is that the AT ‘560 discloses the flat structural components having the structure recited in the claims, but lacks the recited adhesive between the tongue and groove joints. The Examiner asserts, however, that DE ‘962 teaches the use of a contact adhesive in a tongue and groove joint. The Examiner further asserts that each of SCARLETT, KELLER and TURNER disclose the “application of an adhesive upon or within a locking joint between structural members” and, as a result of these teachings, that it would have been obvious “[t]o have provided the floor tile assembly of [AT ‘560] with adhesive between and within the tongue and groove joints.” Applicant respectfully disagrees with the Examiner’s position and assertions.

As a preliminary matter, Applicant notes that claims 1 and 31 have been amended to recite that the adhesive or the substance is applied off-site. As explained in the specification on pages 4 and 5, by applying the adhesive or the substance in advance, it can be applied in dosed form and then delivered to the site. Indeed, the paragraph bridging pages 4 and 5 specifically explains:

Panels already provided with glue--whether the glue is active in advance or becomes active when the panels are joined on site--have the striking benefit that the number of maneuvers and manual stages involved in laying out the panels on site is considerably reduced and in that the step regarded as time-consuming and unpleasant by both the professional and the amateur working at home is eliminated, namely that of applying as uniformly as possible a gluey substance in

sufficient, but not excessive quantity over the entire side length of the groove and/or tongues of the panel on the installation site. This eliminates the problem of the glue setting prematurely during delays in the laying process, such as makes impossible a practically seamless joining. Also eliminated is the unpleasant welling out of excess glue, which must be removed immediately after having left the joints, so as to avoid the formation of spots on the decorative layer.

None of the applied prior art documents recognize the problem which is solved by the instant claimed invention.

Applicant also respectfully submits that the applied documents do not render independent claims 1 and 31, or the claims that depend from them, obvious. AT '560 discloses glueless, interlocking panels. The DE '962 apparently discloses the use of an adhesive on conventional glued panels. No applied document discloses or suggests the use of pre-applied adhesive or substance layers on interlocking panels, much less, that such are applied off-site. Moreover, TURNER and KELLER are completely silent with regard to a pre-applied adhesive layer and SCARLETT suggests only that adhesive may be used to bond together the pieces which form an I-beam.

Taken collectively, the applied references do not disclose or suggest a pre-applied adhesive layer or a pre-applied layer of a substance that activates an adhesive in the specific structures recited in independent claims 1 and 31. It is also apparent that no proper combination of the applied references discloses or suggests that the pre-applied adhesive layer or the pre-applied layer of a substance that activates an adhesive is applied off-site. Accordingly, the cited combination of references does not render obvious independent claims 1 and 31, or the claims that depend from them. Therefore, Applicant respectfully requests that the rejection be withdrawn.

Claims 1-3, 21-25 and 31 were also rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over AT '560 in view of DE '962 and any one of SCARLETT, KELLER, or TURNER, and further in view of U.S. Patent No. 6,004,417 to ROESCH et al. Applicant respectfully traverses this rejection.

The Examiner's position in setting forth this rejection is stated to be the same as that in setting forth the previous rejection under 35 U.S.C. § 103(a). The Examiner further asserts that ROESCH "teach utilization and advantages of various 'two component' adhesives including microencapsulatable solvent adhesives."

As asserted in Applicant's previous response, Applicant respectfully disagrees with the blanket rejection of all of elected claims 1-3, 21-25 and 31 over the cited combination of references. Apparently, judging by the previous rejection, the addition of the ROESCH to the previously cited combination is asserted to render claims 3 and 25 obvious. If so, then only those claims should be included in the rejection, so that Applicant is not faced with the undue burden of responding to cumulative rejections that add nothing of substance or specificity to the prosecutorial record.

Notwithstanding Applicant's position on the rejection itself, Applicant submits that claims 1-3, 21-25 and 31 are not obvious over the cited combination of references for at least the same reasons given above with respect to the previous rejection under 35 U.S.C. § 103(a). Moreover, with respect to the specific teachings of the ROESCH, Applicant respectfully submits that it does not cure the deficiencies of the other documents or render all of the claims obvious, either alone or in combination with the other cited references. In general, Applicant submits that ROESCH merely discloses adhesive compositions specifically for bonding poly(vinyl chloride) (PVC), chlorinated

poly(vinyl chloride) (CPVC) and acrylonitrile-butadiene-styrene (ABS) (i.e., plastic) pipes. Applicant notes that these are not necessarily the same types of adhesives that would be used in configurations according to claims 1 and 31.

Furthermore, regardless of the particular disclosures of ROESCH, Applicant submits that it does not remedy the “defects” of the other cited references that were noted above. More particularly, ROESCH does not disclose or suggest a pre-applied adhesive layer or a pre-applied layer of a substance that activates an adhesive in the type of structures recited in independent claims 1 and 31, much less, ones which are applied off-site. Accordingly, Applicant respectfully submits that the cited combination of references does not render claims 1-3, 21-25 and 31 obvious, and respectfully request that the rejection be withdrawn.

New Claims Are Also Allowable

Applicant submits that the new claims 32-36 are allowable over the applied art of record. Specifically, claims 32 and 33 depend from claims 1 and 31 and further recite that the pre-applied adhesive layer or the pre-applied layer of a substance which activates an adhesive is applied in an amount which is insufficient to cause any excess to well out onto a decorative surface of the flat structural panels or components when the flat structural panels or component are joined together. Claims 34-36 recite features similar to claims 1 and 32 and include the pre-applied adhesive layer or the pre-applied layer of a substance which activates an adhesive. Such features are not disclosed or suggested by the applied art of record. Accordingly, Applicant respectfully requests

consideration of these claims and further request that the above-noted claims be indicated as being allowable.

Rejoinder of non-elected claims

Applicant submits that if generic claim 1 is found to be allowed or allowable, the species requirement with respect to claims 4-20 and 26-30 would be improper and should be withdrawn, i.e., claims 4-20 and 26-30 depend from claim 1 and should therefore be rejoined. Applicant refers the Examiner to MPEP 821.04 which stands for the proposition that withdrawn claims which depend from or otherwise include all the limitations of the allowable claims will be rejoined if presented prior to allowance and issuance of a final rejection. As the instant Amendment is being made prior to a final rejection and allowance, Applicant respectfully requests entry and allowance of previously withdrawn claims 4-20 and 26-30, if and when claim 1 is found allowable.

CONCLUSION

In view of the foregoing amendments and remarks, Applicant submits that all the claims are allowable over the cited references and that the application itself is in condition for allowance. The examiner is respectfully requested to pass this application to issue. The examiner is invited to contact the undersigned at the telephone number listed below, if needed. Applicant hereby makes a written conditional petition for an extension of time, if required.

Please charge any deficiencies in fees and credit any overpayment of fees to
Deposit Account No. 19-0089.

Respectfully submitted,
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